

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

- (1) provisionally rejected claims 1-15 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-14 of co-pending U.S. Patent Application No. 10/525,733 (the '733 application);
- (2) objected to the specification; and
- (3) rejected claims 1-15 under 35 U.S.C. § 112, second paragraph.

By this Amendment, Applicants have amended the specification and claims 1, 6-8, and 12-15. No claims are added or cancelled. Accordingly, claims 1-15 remain under examination.

**I. Double-Patenting Rejection of Claims 1-15**

Applicants respectfully traverse the provisional double-patenting rejection of claims 1-15 and request that the rejection be held in abeyance. The '733 application is currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Since no patent has apparently issued from the '733 application, Applicants respectfully request that the provisional rejection be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

**II. Objection to the Specification**

The Office Action objected to the Abstract of the disclosure for allegedly including improper language and being of improper form. Office Action at 3. Applicants respectfully traverse, and respectfully submit that the Abstract is within a range of 50 to 150 words, does not include the terms "means" or "said," and does not include the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

phrases “[t]he disclosure concerns,” “[t]he disclosure defined by this invention,” or “[t]he disclosure describes.” However, in an effort to advance prosecution, Applicants attach hereto a Replacement Abstract. Accordingly, Applicants respectfully request the reconsideration and withdrawal of this objection.

**III. Rejection of Claims 1-15 under 35 U.S.C. §112, second paragraph**

Applicants respectfully traverse the rejection of claim 1-15 under 35 U.S.C. §112, second paragraph. In particular, the Office Action alleges that the phrases “the lower part of the skin,” “the phonatory organ,” the vocal chords,” and “said input speech,” as recited by independent claim 1 and 15, lack sufficient antecedent basis. Office Action at 4. Further, the Office Action also alleges that the phrase “non-audible murmur,” as recited by independent claims 1 and 15, “is vague since it is not clear what the limitation is.” Id. Without acquiescing to the propriety of these characterizations, Applicants have amended independent claims 1 and 15 to overcome the rejection. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1 and 15 under 35 U.S.C. §112, second paragraph.

Moreover, Applicants respectfully assert that during examination of claims for compliance of 35 U.S.C. § 112, second paragraph, the Examiner should focus on “whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” M.P.E.P. § 2173.02. Further, “[a]cceptability of claim ... language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” M.P.E.P. § 2173.05(b). Therefore, if one of ordinary skill in the art would be reasonably

apprised of the scope of the invention, in light of the specification, any rejection under 35 U.S.C. § 112, second paragraph, is improper. *See id.*

Applicants respectfully submit that one reasonably skilled in the art, in view of at least the disclosure from page 9, line 2 to page 10, line 10 and page 22, lines 1-17 of the originally-filed specification, would understand that the claimed “non-audible murmur” represents non-audible vibrations caused by, for example, the movement of vocal cords of a first person when the first person moves his vocal cords to speak at a level that is not understandable by persons other than the first person. This arrangement would ensure that the first person would be able to communicate on the phone such that a second person sitting close to the first person would not be able to hear the conversation, thus maintaining the privacy of the conversation.

For example, the originally-filed specification discloses that “the non-audible murmur” is not heard by surrounding people. *See* originally-filed specification, page 9, line 2 through page 10, line 10, and page 22, lines 1-17. In this connection, the non-audible murmur is different from a whisper, which may be heard by surrounding people, and the non-audible murmur may be sampled through a microphone utilizing flesh conduction instead of air conduction. *Id.*

Further, the claimed microphone is capable of collecting both audible and non-audible sounds, even if the audible range is different depending on the age or gender of a person. *Id.* Non-audible murmurs may include vibratory sounds which result from the conduction of non-audible respiratory sounds of infinitesimal quantities (the quantity of expiration and that of inspiration) by soft tissues in the body, and are regular vibrations of the vocal cords articulated by variations in resonance filter characteristics

accompanying the motions of phonatory organs and are not intended to be heard by one or more persons surrounding the person having the vocal cords. *Id.*

Accordingly, one of ordinary skill in the art would understand what is claimed, in light of the specification. Therefore, the rejection of independent claim 1 and 15 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn for at least this additional reason.

Claims 2-14 depend from independent claim 1. As Applicants have traversed the rejection of the independent base claim from which these claims depend, Applicants respectfully request the reconsideration and withdrawal of the rejection of these dependent claims under 35 U.S.C. § 112, second paragraph.

### CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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